

5 **I. General Remarks Concerning This Response**

Claims 1-35 are currently pending in the present application. No claims have been amended, added, or canceled in this response. Reconsideration of the claims is respectfully requested.

10 **II. 35 U.S.C. § 102(e) - Anticipation**

The Office action has rejected claims 1, 18, 23, and 27 under 35 U.S.C. § 102(e) as anticipated by Bachman et al., "System and method for session management", U.S. Patent Number 5,907,621, filed 11/15/1996, issued 05/25/1999. This rejection is traversed.

15 The rejection of claims 1, 18, and 23, each of which are independent claims, focuses on independent claim 1; the rejection states in its entirety:

20 As per claims 1, 18, and 23, Bachman discloses "a method for determining whether to allow access to a protected resource from a server, comprising the steps of: at a client, responsive to a request to retrieve the protected resource, generating a one-time only piece of data (the random number is the unique and the non-repeat piece of data for the session cookie) which can be used to authenticate that the request is bound to a given identity contained in a cookie previously set by an authentication server; forwarding the piece of data to the server in the request; at the server, determining whether the piece of data is valid" in (Col 2 lines 10-25, and Col 3 line 34 to Col 4 line 10); and Bachman teaches "if the piece of data is valid, executing an access control decision to determine whether to invoke the request" in (Col 4 lines 19-28).

25 The rejection misrepresents the teachings of Bachman et al.. The rejection states that "the random number is the unique and the non-repeat piece of data for the session cookie", and the rejection implies that "the random number" is generating at the client. This is incorrect. The random number to which the rejection is referring is random information that is generated by the server. Bachman et al. states in column 3, lines 34-47:

5 The user identity information is passed to the session object 217 which sets up a session by generating a session token from a hash of the identity information, from an index and from random numbers R0 and R1. R0 is the primary random number for this session and will not change during the existence of the session. R1 is a transaction random number and it changes every time a new token is generated so that tokens are modified during this session in order to provide randomness and prevent token replay. The identity information, random information R0, R1 and other information such as an account list and the page transmission time T are stored in a session table 221 at the index entry I used to create the token.

10

15 Bachman et al. then states at column 3, line 59: "The token is also placed in each hypertext link in the page." Finally, Bachman et al. states at column 4, lines 4-7:

20 The web requestor object 211 then passes the formatted page to the server program 201 for transmission to the gateway 15 and client 23 where it is displayed to the authorized user.

Bachman et al. clearly teaches that the random information is generated at the server, then passed to the client.

25 In contrast, the present invention generates the "one-time only use piece of data" at the client; this feature is clearly recited in the independent claims. For example, the first element of claim 1 recites (emphasis added):

30 **at a client, responsive to a request to retrieve the protected resource, generating a one-time only use piece of data** which can be used to authenticate that the request is bound to a given identity contained in a cookie previously set by an authentication server;

35 Thus, Bachman et al. does not disclose a feature of the claimed invention, notwithstanding the argument in the rejection. The argument concerning the above-noted deficiency of Bachman et al. is also applicable to independent claims 18 and 23 and dependent claim 27, which depends from claim 23.

40 Bachman et al. clearly does not disclose features as required by the language of the independent claims of the present application. As stated at MPEP § 2131: "A claim is anticipated

only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Bachman et al. cannot be used as an anticipatory reference, and the anticipatory rejection of the claims have been overcome, whereby Applicant requests the withdrawal of the rejection.

III. 35 U.S.C. § 103(a)–Obviousness

The Office action has rejected 2-17, 19-22, 24-26, and 28-35 under 35 U.S.C. § 103(a) as unpatentable over Bachman et al., either singly or in combination with one or more other references. These rejections are traversed.

The Office action rejected claims 1, 18, 23, and 27 under 35 U.S.C. § 102(e). The Office action then rejected all remaining claims, i.e. all claims other than those rejected under 35 U.S.C. § 102(e), using obviousness rejections that employed Bachman et al. as a primary reference, either alone or in combination with one or more other references. These rejections must be withdrawn because Bachman et al. does not qualify as prior art against the present application under 35 U.S.C. § 103(a).

All rejections under 35 U.S.C. § 103(a) logically rely on the relationship of the applied prior art to the claimed invention under 35 U.S.C. § 102. In other words, before the prior art can be properly applied against the claimed invention with respect to 35 U.S.C. § 103(a), the prior art must have a specific, statutorily defined relationship to the claimed invention as set forth in one of the subsections of 35 U.S.C. § 102. Some of the subsections of 35 U.S.C. § 102 statutorily deny

5 patentability of a claimed invention if prior art exists that identically discloses the claimed invention. If there is prior art that does not identically disclose the claimed invention, then 35 U.S.C. § 103(a) can be used to prevent patentability if the claimed invention is obvious in view of the prior art. The relationship between 35 U.S.C. § 103(a) and 35 U.S.C. § 102 is stated in the statute:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

15 The pending rejection uses various references in view of Bachman et al. to deny patentability of the present invention under 35 U.S.C. § 103(a). An assumption underlies the grounds of rejection that Bachman et al. can be used to reject the claims under 35 U.S.C. § 103(a) because Bachman et al. qualifies as prior art under 35 U.S.C. § 102(e).

20 However, this assumption is incorrect. An inspection of Bachman et al. reveals that this patent is currently assigned to International Business Machines Corporation (IBM). The subject matter of Bachman et al. was owned by IBM and subject to an obligation of assignment to IBM at the time that the present invention was made. In addition, at that same time, the present invention was owned by IBM and subject to an obligation of assignment to IBM. Hence, the present invention and the subject matter in Bachman et al. were owned by a common assignee, i.e. IBM, at the time that the present invention was made.

25 30 35 The American Inventors Protection Act (AIPA) of 1999 changed 35 U.S.C. § 103(c), which applies to any patent application filed on or after the date of enactment, November 29, 1999.

35 U.S.C. § 103(c) states:

5 (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10 In other words, prior art that would otherwise qualify under 35 U.S.C. § 102(e) cannot be used to deny patentability if the prior art and the claimed invention were commonly owned or subject to an assignment to a common assignee at the time of the invention.

15 35 U.S.C. § 103(c) is applicable to the present invention because the present application was filed on 05/31/2000, and Bachman et al. is disqualified by 35 U.S.C. § 103(c) as prior art against the present invention under 35 U.S.C. § 103(a). Since the grounds of the pending rejection can no longer be based on Bachman et al., the pending grounds of rejection must be withdrawn.

20 **IV. Conclusion**

25 It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a Notice of Allowance. For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

DATE: 10/23/06 Respectfully submitted,

Jeffrey S. LaPew
Reg. No. 31,633
Attorney
IEM Intellectual Property Law
Austin, Texas 78758